

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John Scumniotales et al.
Application No. : 10/613,534
Filed : July 3, 2003
For : METHOD AND SYSTEM FOR OBJECT-ORIENTED
MANAGEMENT OF MULTI-DIMENSIONAL DATA

Examiner : James A. Vezeris
Art Unit : 3693
Docket No. : 730128.401
Date : February 9, 2009

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents:

In response to the Restriction Requirement dated January 7, 2009, Applicants hereby provisionally elect **with traverse**, Group II, claims 32-100 for examination at this time. Applicants are traversing this Restriction Requirement in order to **propose modification of Group II to again include claims 23-31 and to combine claims 23-100 for examination for the reasons discussed below.** Accordingly, in the event Applicants' suggestion is approved, elected and **revised Group II would again include claims 23-100.**

Specifically, claims 23-100 are currently pending in this application. Claims 1-22 and 101-236 were previously withdrawn by the Examiner consistent with an initial Restriction Requirement of November 29, 2007. Also, in that action, the Examiner initially restricted claims 23-31 from claims 32-100. Applicants traversed that restriction in a response dated December 27, 2007 requesting the Examiner to expand the elected group to examine claims 23-100. In an Office Action dated March 25, 2008, the Examiner subsequently agreed to expand the group to claims 23-100, and examined these claims on the merits. Thereafter, in the present

Restriction Requirement, the Examiner has once again restricted out Group I (claims 23-31), stating that Applicants' amendment has necessitated this restriction. (See Restriction Requirement, dated January 7, 2009, page 3 (hereinafter "Current Restriction").)

Applicants respectfully and earnestly request the Examiner to again modify his restriction and to include claims 23-31 in Group II to be examined with claims 32-100. The Examiner lists several reasons for the restriction: that the subcombination of Group I has separate utility such "as representing transaction data as opposed to actual investments holdings" and "that there would be a serious search and examination burden if restriction were not required because one or more of the following apply": different classification, different status in the art due to recognized divergent subject matter, require a different field of search, prior art applicable to one invention would not likely be applicable to the other, or the are likely to raise different non-prior art issues. (See Current Restriction, pp. 2-3.)

First, Applicants wish to point out that even if Group I may have separate utility, the Examiner cannot meet the needed requirement that "there would be a serious search and examination burden" because the Examiner has already searched and examined this amended language in preparing the first Office Action. Specifically, the Examiner must show that the inventions are independent or distinct as claimed AND that there is a serious burden on the Examiner if restriction is not required. (M.P.E.P. 803(I).) In this case, Applicants' amendments to Group I could not have "created the need for restriction" as suggested by the Examiner, because the amended language to which the Examiner refers was already present in a dependent claim which the Examiner already searched and examined.

Specifically, independent claim 23 was amended to include language already present and previously examined in dependent claim 27, which depends from claim 23. Dependent claim 27 as presented for examination prior to the first Office Action recited:

27. The system of claim 23 wherein ***the portfolio data includes financial investments*** and project management characterizations.

(emphasis added). In the amendment of August 22, 2008, this language was deleted from claim 27 and added (moved) into independent claim 23, so that claim 23 now recites:

23. (As Amended) A computer system for managing and analyzing enterprise portfolio data, comprising:

a memory;

a portfolio manager component that is stored in the memory and that is structured, when executed, to add to a portfolio representation structure items that correspond to transactions on the portfolio data, *the portfolio data including financial investments*; and

a portfolio analyzer component that is stored in the memory and that is structured, when executed, to present a plurality of views of the portfolio data as represented by the portfolio representation structure, wherein the views dynamically calculate and present multi-dimensional characterizations of the portfolio data while items are added using the portfolio manager.

(portion of amendment emphasized).

Therefore, regardless of whether claims 23-31 may have separate utility, there can be no serious additional search and examination burden on the Examiner, because the Examiner has already searched and examined this language in the context of claim 23.

Second, the Examiner already considered the concept of financial investments as part of portfolio data in his examination of at least one of the claims in Group II. In particular, the Examiner searched and examined “financial investments” as part of portfolio data when examining claim 44, which depends from claim 32 in Group II: “object instances represent data from categories of investments” – claim 23; “investments are part of an enterprise portfolio management system” – claim 43; and “investments comprise... types in the form of at least two of financial investments...” – claim 44. Thus, it is difficult to understand how one would not have to search similar, if not the same, prior art to examine both claims 23 and 44.

Third, the other factors the Examiner lists as possibly creating a “serious burden” are also not present. Namely, the groups are not classified differently – they are classified in the same class/subclass, 705/36R. Also, the subject matter of the groups cannot be said to require different fields of search, be considered divergent, or require the application of different prior art – as the subject matter of both groups has already been searched and the same prior art (Azuma U.S. Patent No. 6,954,761) has been cited by the Examiner against all of claims 23-100. Thus, the Examiner cannot now reasonably assert a serious burden of search and examination for claims already searched and examined together using the same prior art.

Fourth, the Examiner claims that Applicants' amendments to the claims caused the need for the restriction, but then cites that a separate utility for Group I is that it can be used "for representing transaction data as opposed to actual investments holdings." (See Current Restriction, p. 2.) Even though Applicants do not necessarily agree with this characterization, it is worthy to note that the language "items that correspond to transactions on portfolio data" of Group I refers to language that has been present in the claim 23 prior to the first Office Action. There could not now be a serious burden to address this asserted utility separately. Applicants reserve the right to traverse this characterization later as necessary.

Accordingly, amending Group II to include all of claims 23-100 should not impose any additional search and examination burden on the Examiner, and a restriction is not proper.

Based upon the above recommendations, Applicants respectfully request modification of the Restriction Requirement and prompt consideration of the elected claims. If the Examiner has any questions, the Examiner is encouraged to promptly contact Applicants' representative at (206) 622-4900 to resolve any such issues.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

A handwritten signature in cursive script that reads "Ellen M. Bierman". The signature is written in dark ink and is positioned above a horizontal line.

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